

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellants: SUNDARESAN, et al. Patent Application
Application No.: 10/676,219 Group Art Unit: 2141
Filed: October 1, 2003 Examiner: Gillis, Brian J.

For: METHOD AND APPARATUS FOR TRANSACTION TRACKING IN A WEB PRESENTATION ARCHITECTURE

REPLY BRIEF

In response to the Examiner's Answer mailed on April 14, 2008, Appellants respectfully submit the following remarks.

REMARKS

Appellants are submitting the following remarks in response to the Examiner's Answer. In these remarks, Appellants are addressing certain arguments presented in the Examiner's Answer. While only certain arguments are addressed in this Reply Brief, this should not be construed that Appellants agree with the other arguments presented in the Examiner's Answer.

Additional Notice dated May 2, 2008

Appellants called Examiner Gillis on May 13, 2008 regarding the Additional Notice dated May 2, 2008. Examiner Gillis conveyed that the Final Office Action dated October 25, 2007 had provided an incorrect list of rejected claims. The Additional Notice provided a corrected list of rejected claims. Examiner Gillis also conveyed that Appellants were not required to respond to the Additional Notice, for example, with an Amended Appeal Brief.

Response to Argument on Page 13, Third paragraph of the Examiner's Answer

The Examiner's Answer states, "...the specification fails to provide any reference to tangible machine-readable medium." Appellants respectfully submit that any one of ordinary skill in the art would understand what a tangible machine-readable medium is.

Response to Argument on Page 13, Last Paragraph, through Page 14, First Paragraph of the Examiner's Answer

"As reiterated by the Supreme Court in KSR, the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in Graham v. John

Deere Co., 383 U.S. 1, 148 USPQ 459 (1966). Obviousness is a question of law based on underlying factual inquiries” including “[a]scertaining the differences between the claimed invention and the prior art” (MPEP 2141(II)). “In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious” (emphasis in original; MPEP 2141.02(I)). Appellant notes that “[t]he prior art reference (or references when combined) need not teach or suggest all the claim limitations, however, Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art” (emphasis added; MPEP 2141(III)).

Appellants respectfully submit that “[i]t is improper to combine references where the references teach away from their combination” (emphasis added; MPEP 2145(X)(D)(2); In re Grasselli, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983)). Appellants respectfully note that “[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention” (emphasis in original; MPEP 2141.02(VI); W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)). Appellants respectfully submit that there is no motivation to combine the teachings of Oulu and Wilson, because Wilson teaches away from the suggested modification.

The Examiner's Answer states, "...Oulu et al teaches a probe is able to interface with a database or a logging program to report various measurements in association with particular transactions (paragraph 38)." Appellants respectfully disagree.

Appellants understand Oulu to teach the following: Appellants understand Oulu to use the word "probe" to refer to an entity that performs the action of inserting code into application components (0064) and also at times to use the word "probe" to refer to the code that was inserted into the application components (0044, 0084). According to one embodiment, Oulu's application has a probe/inserted code that monitors the application 102 and reports (abstract, 0043, 0076, 0077, 0080, 0044, 0084). Appellants understand Oulu's database to provide storage.

Appellants do not understand Oulu to teach an application that has an interface that provides the application with an ability to cause a logging program to log data collected by a plurality of transaction managers. Appellants do not understand Oulu to teach "a logging program." Appellants do not understand Oulu's probe/inserted code, or any other entity taught by Oulu, to cause a logging program to log data. Appellants do not understand Oulu's probe/inserted code, or any other entity taught by Oulu, to provide Oulu's application with an ability to interface with a logging program. Appellants do not understand Oulu's probe/inserted code, or any other entity taught by Oulu, to enable Oulu's application to interface with a logging program to log data collected by a plurality of transaction managers.

The Examiner's Answer states on page 14, "Wilson et al. teaches the ability for multiple agents or probes to monitor different types of activity which is reported back to a console and storing it in a database (column 5, lines 26-55), therefore providing the ability to interface with a logging program to store data collected by the multiple agents.

Appellants respectfully submit that Wilson teaches away from Oulu and therefore the teachings of Wilson and Oulu cannot be combined to arrive at the embodiment recited by Claim 1. For example, Wilson teaches away from "intrusive approaches" that require editing, recompiling or are dependent upon the cooperation of vendor providers of an application program (Col. 2 line 64 to Col. 3 line 6). Appellants understand Oulu's probe/inserted code to teach an "invasive approach" that involves modifying code.

Therefore, Appellants submit that independent Claim 1 is not obvious over Oulu and Wilson, alone or in combination, as the Rejection fails to establish a *prima facie* case for obviousness for at least the reason that Claim 1 recites "the application with an ability to interface with a logging program to log data collected by the plurality of transaction managers." For similar reasons, Appellants submit that independent Claims 9, 17 and 25 are not obvious over Oulu and Wilson, alone or in combination, in that independent Claims 9, 17 and 25 also recite "the application with an ability to interface with a logging program to log data collected by the plurality of transaction managers."

In view of the above remarks, Appellants continue to assert that the combination of Oulu and Wilson do not teach, describe, or suggest the claimed embodiments, for reasons presented above and for reasons previously presented in the Appeal Brief.

Respectfully submitted,
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